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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,386	06/03/2005	Manel Torres	08940004AA	4379
30743 7590 05/26/2009 WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190				
EXAMINER JOHNSON, JENNA LEIGH				
ART UNIT		PAPER NUMBER		
1794				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,386

Applicant(s)

TORRES ET AL.

Examiner

Jenna-Leigh Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1 - 16, in the reply filed on March 6, 2009 is acknowledged.

Response to Amendment

2. The Amendment submitted on September 29, 2008, has been entered. Claims 25 - 30 have been cancelled. Claims 1 and 21 have been amended. Therefore, the pending claims are 1 - 24. Claims 17 - 24 are withdrawn from consideration as being drawn to a nonelected invention.
3. The rejection of claims 17 - 24 are withdrawn due to the fact that those claims are now drawn to a non-elected invention.
4. The 35 USC 102 and 35 USC 103 rejections over Laurent (EP 0165880) is withdrawn since Laurent fails to teach using a diluent with a boiling point of not more than 70°C. However, a new rejection based on Laurent is set forth below.
5. The 35 USC 103 rejection based Nakanishi (JP 05186949) is withdrawn since Nakanishi fails to teach using a diluent with a boiling point of not more than 70°C.

Claim Objections

6. Claims 12 and 13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 12 and 13 recite that the diluent can be water. However, water has a boiling point which is higher than 70°C. Therefore, the dependent claims are considered to be broader than claim 1.

Claim Rejections - 35 USC § 103

7. Claims 1 - 6 and 10 - 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laurent.

Laurent teaches a sprayable composition to decorate interiors comprising fibers, water (a suitable non-toxic diluent as described by Applicant [0022 | 0050]), and polymer binder ({Laurent} Machine Translation Page 2 | Claims 1-11 | Examples 1-6). Regarding Claims 2 and 6, the binder is a polyvinyl alcohol. Regarding Claim 10, at least 40% cellulose fiber is taught for the compositions. Polyolefin fibers can be substituted for the cellulose fiber, which meets Applicant's limitation of a synthetic fiber of at least 40-% ({Laurent} Page 2). Regarding Claims 11-14, others compositions contain rockwool fibers and synthetic fibers of 82 parts weight to a binder of 100 parts weight ({Laurent} Example 4). Regarding Claim 15, a powdered calcium carbonate is used ({Laurent} Example 5).

However, Laurent fails to teach using diluents other than water. It is well known that diluents are added to mixtures to help dissolve and mix the components of the mixtures as well as control the viscosity. Further, it is known that like dissolves like, i.e., polar diluents dissolve polar materials, and that similar types of diluents, i.e., polar diluents or non-polar diluents, will dissolve a mixture with similar results. It is well known that lower molecular weight alcohols such as methanol, or ethanol, are similar to water since they are both polar compounds with similar end groups. Thus, one of ordinary skill in the art would have a reasonable expectation that the substitution of lower molecular weight alcohols, for the water component taught by Laurent would dissolve the composition and produced the desired mixture, with a similar ability to control and optimize the viscosity of the mixture. Further, one of ordinary skill in the art would understand that using a diluent with a lower melting point would require less energy to remove the diluent from the final product. Thus, claims 1, 2, 6, and 10 - 15 are rejected.

Laurent is silent regarding the specific properties of the composition constituents. Based on the description by Applicant regarding properties of the binder ({Applicant} [0025]), because the binder types taught by Laurent are substantially identical, they would also be expected to have similar glass transition temperatures ({Laurent} Examples 1-6). At the time of the invention, it would have been obvious to use a sprayable fiber composition and claim properties of constituent materials for the

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composition for forming a fabric {Laurent}. Though unrecognized at the time, the glass transition temperature of a substantially identical material is expected to be the same, and is unpatentable; see *in re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). Thus, claims 3 and 4 are rejected.

Further, one with ordinary skill in the art would wish to optimize the properties of the binder, with regard to molecular weight, to help control the texture and viscosity of the composition so that the mixture can be applied to create a coating on a surface without clumping or being too thin. It would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the molecular weight and viscosity, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). Therefore, claims 5 and 16 are rejected.

8. Claims 7 - 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laurent in view of O'Connell (EP 0083960).

The features of Laurent have been set forth above. Laurent fails to teach the length of the fibers in the mixtures. O'Connell is drawn to a sprayable composition for acoustical applications comprising fibers, water, and a polymer binder ({O'Connell} Pages 4 & 6). Polyvinyl acetate and polyvinyl alcohol are taught as suitable binders to bind the fiber. The fibers have a length between about 0.5-mm to about 5-mm ({O'Connell} Page 3). Thus, it would have been obvious to choose shorter fibers with length between about 0.5 and about 5 mm, as taught by O'Connell, in the composition of Laurent. Claim 9 is unpatentable because the range is sufficiently close and there is a reasonable expectation that the fabric would have the same properties based on the similarity of the materials used; see *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Further, it would have been obvious to one having ordinary skill in the art to optimize the molecular length of fibers, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA

1955). One of ordinary skill in the art would be motivated to choose a fiber length that can be easily applied as a coating onto a surface, as desired by Laurent, without being too long to clump together. Thus, claims 7 - 9 are rejected.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Johnson whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlj
May 22, 2009

/Jenna-Leigh Johnson/
Primary Examiner, Art Unit 1794